

## REMARKS

The above amendments and these remarks are responsive to the Office action dated July 11, 2005. Claims 1-19 are pending in the application. In the Office action, claims 1-3, 5-9, 10-16, and 18-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,226,969 to Denoual, and claims 4 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoual in view of U.S. Patent No. 3,155,391 to Chittenden. Applicants respectfully traverse the rejections after careful study of the cited references, and request reconsideration of the same in consideration of the foregoing amendments and the following remarks.

### Amendments to the Claims

Dependent claims 1, 9, 10, and 19 are amended to clarify the subject matter for which protection is being sought. The amendments essentially consist of substituting the phrase “*adapted to indicate*” for the term “*indicating*,” and/or making typographical changes consistent with this substitution. No new matter is entered by way of the amendments.

### Rejections under 35 USC § 102

For a reference to anticipate a claim under 35 U.S.C. § 102(b), the reference must disclose each and every element of the claim.<sup>1</sup> The Office action asserts that Denoual anticipates pending claims 1-3, 5-9, 10-16, and 18-19. However, applicants assert that Denoual clearly fails to disclose several elements of at least independent claims 1, 9, 10, and 19.

For example, amended claims 1 and 19 both recite, in part, movable game pieces each with first and second faces, “*each face having ... directional indicia adapted to indicate a*

---

<sup>1</sup> See *Verdegraal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

*direction.”* Amended claim 9 recites, in part, “*two-sided game pieces, each side of which includes ... directional indicia adapted to indicate a direction.*” Amended claim 10 recites, in part, providing game pieces that include first and second faces each bearing “*directional indicia adapted to indicate a direction.*”

The Office action asserts that the indicia 12w and 12b on the Denoual movable game pieces are directional indicia.

However, Applicants note that indicia 12w/12b is a black or white ring located in the exact center of a circularly shaped, opposingly-colored playing piece (*see* Figs. 2A and 2B). As such, applicants submit that indicia 12w/12b is not—and cannot be—adapted to indicate a direction, as recited in claims 1, 9, 10, and 19.

Rather, Denoual quite clearly indicates that the indicia 12w/12b (colored ring), as well as other indicia 22w/22b (colored circle) and 32w/32b (solid color), are adapted to differentiate the various types and/or sets of playing pieces from each other, an altogether different function than directional indication. Denoual states specifically that “the pieces bear markings, colors, shapes or like indicia which distinguish the three types” (2:31-32), with each type of piece moving and capturing according to individual rules for that type of piece (2:27-28). More particularly, the plurality of movable pieces divisible into two sets, each set “comprising one emperor piece, six ambassador pieces, and seven governor pieces” (2:63-64), each category being identifiable via the various indicia, and/or by size or other characteristic (6:41-7:27).

Thus, the various circular indicia are adapted to indicate a category or type or piece, *not* a direction. As such, Denoual fails to teach game pieces with directional indicia adapted to indicate a direction, as recited in claims 1, 9, 10, and 19.

Applicant notes also that indicia 12w and/or 12b appear on only *one* of each set of pieces

in the Denoual reference (*see* Fig. 1; *see also* 2:62-64 and 3:25-26). Thus, Denoual fails to teach movable pieces *each* with the indicated indicia, as recited in claims 1, 9, and 10.

Claim 10 also recites additional limitations not disclosed in the Denoual reference. For example, claim 10 recites, in part, “*comparing player alignment indicia ... on a first game piece to that one a second game piece indicated by the directional indicia on the first game piece.*” Denoual fails to disclose any such step, and the Office action fails to indicate that this element is disclosed anywhere in Denoual. Applicants note that since the Denoual game pieces lack directional indicia, the various pieces cannot directionally indicate other game pieces to which the game pieces may be compared, as recited in claim 10.

For at least the aforementioned reasons, applicants submit that the rejection under 35 U.S.C. § 102(b) of independent claims 1, 9, 10, and 19 should be withdrawn. Further, the other claims rejected under 35 U.S.C. § 102(b) depend from and further limit the independent claims discussed above. The rejections of the dependent claims should accordingly be withdrawn.

#### Rejections under 35 USC § 103

Dependent claims 4 and 17 stand rejected as being obvious under 35 U.S.C. § 103(a) over Denoual in view of Chittenden. In order to establish a *prima facie* case of obviousness, the Office action must satisfy three basic criteria: (1) the prior art references must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation to modify the reference or to combine reference teachings to arrive at the claimed invention; and (3) there must be a reasonable expectation of success. *See* MPEP § 2143.

With respect to (1), the Office action fails to present a *prima facie* case of obviousness because the cited references, either alone or in combination, fail to teach or suggest all of the limitations of the rejected claims. For example, independent claims 1 and 10, from which claims

4 and 17 depend, are demonstrated above to recite several limitations that Denoual fails to disclose. Chittenden similarly fails to disclose the cited limitations.

For example, as mentioned above, claims 1 and 10 (and thus claims 4 and 17) recite, in part, game pieces with faces each bearing “*directional indicia adapted to indicate a direction.*” The Office action asserts that “Chittenden teaches arrows on game pieces for direction (56).” However, directional indicia 56 is shown in Fig. 5 to be on an insert 52, which forms part of the *playing surface* (4:30-55). Insert 52 is not a “game piece” as the term is used in the specification and claims.

Incidentally, applicants further note that the Chittenden game pieces 42 and 90 (in Figs. 3 and 4, respectively), also fail to include directional indicia: the embossed symbols 48, 96 (an airplane and a missile, respectively) are adapted to indicate the *type* of playing piece (4:11-19; 5:51-53), rather than a direction. Thus, Chittenden fails to teach at least this element of claims 1 and 10.

Moreover, by virtue of their dependent status, claims 4 and 17 include additional limitations that are not disclosed by the cited references. For example, claim 4 depends from claim 2, which recites, in part, “*wherein player alignment indicia is represented by one or more graphic images.*” However, both Chittenden and Denoual teach the use of *color* as player alignment indicia, not graphic images. As another example, claim 17 depends indirectly from 13, a method claim that recites reorienting a game piece in a manner not disclosed by either Denoual or Chittenden.

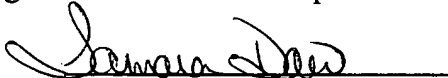
Thus, since Chittenden fails to teach at least the aforementioned elements of claims 4 and 17, no combination of Chittenden with Denoual will obviate claims 4 and 17.

Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowance covering the pending claims. However, the Examiner is invited to contact the undersigned attorney of record if any questions remain, or if a telephone interview would in any way advance prosecution of the application.

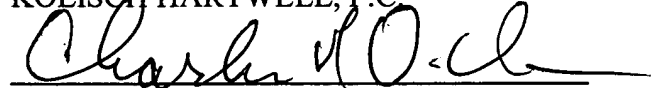
**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 30, 2005.

  
Tamara Daw

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Charles H. DeVoe

Registration No. 37,305

Customer No. 23581

Attorney/Agent for Applicant(s)/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679